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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,300	05/15/2001	Jay S. Walker	00-030	8793

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/855,300	Applicant(s) WALKER ET AL.	
	Examiner JOHN VAN BRAMER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-7,10,13-16,19 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,10,13-16,19 and 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on February 9, 2009 , cancelled claims 2-4, 8-9, 11-12, 17-18, 20-39, and 43. Claims 1, 5, 7, 40, 41, and 42 have been amended and no claims were added. Thus, Claims 1, 5-7, 10, 13-16, 19, and 40 – 42 are pending.

Claim Rejections - 35 USC § 101

2. The amendment filed on February 9, 2009 has overcome the 35 USC 101 rejection of claim 41 raised in the Office Action dated December 9, 2008. Thus, the examiner hereby withdraws the rejection.
3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. The amendment filed on February 9, 2009 has failed to correct the 35 U.S.C. 101 deficiencies of claims 1, 5-7, 10, 13-16, 19, 40 and 42. Claims 1, 5-7, 10,13-16, 19, 40 and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the method steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. The amendment to independent claims 1, 40, and 42 has attempted to incorporate a particular apparatus, but the claimed apparatus is included in such a way as to be considered "insufficient extra solution activity". Claim 1, is claiming a billing statement wherein the offer pointer was selected by a controller. As per 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Here, the applicant is claiming a billing statement comprising viewable electronic data, the viewable electronic data comprises an offer pointer. How the offer pointer got there is not under the scope of control of the claimed billing statement. As such, the "wherein" clause does not require that the step is performed, but rather assumes that such an event has occurred already. Thus, the claim as currently written fails to tie method to a particular apparatus, since the only apparatus is mentioned in an optional "wherein" clause. The examiner suggests amending the claim to positively recite "selecting, by a controller in communication with at least one issuing bank device, an offer pointer associated with the transaction". Claim 19 a method comprising "transmitting by a controller". The act of transmitting and receiving is

considered “insufficient extra solution activity” and as such the claim fails to satisfy the 35 USC 101 requirements. Claim 42 recites a method comprising "receiving from a consumer device" and "transmitting, by a controller". The act of transmitting and receiving is considered “insufficient extra solution activity” and as such the claim fails to satisfy the 35 USC 101 requirements. Dependent claims 5-7, 10, 13-16 fail to correct the deficiencies of the independent claims from which they depend and as such are rejected by virtue of dependency.

Claim Rejections - 35 USC § 112

5. The amendment filed on February 9, 2009 has corrected the 35 U.S.C. 112 deficiencies in Claim 38 and Claim 39 by cancelling claims 38 and 39. Thus the examiner hereby withdraws the rejections.
6. Claims 1, 5-7, 10, 13-16, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 recites “the offer pointer is not associated with any other transactions described in the billing statement”. The examiner is unable to find in the specification any indication of checking the billing statement to ensure that the offer pointer is not associated with any other transactions that are described. The

examiner has not raised the objection in regard to the other independent claims because associating an offer with one of a plurality of transactions does is not as limiting of a statement as the negative limitation recited by independent claim 1, which requires actively checking the billing statement to ensure that no association of any type can be found with any of the other transactions. The examiner is unable to find such a disclosure in the specification and as such independent claim 1 fails to comply with the written description requirement. Dependent claims 5-7, 10, 13-16, and 19 are rejected by virtue of dependency.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 5, 6, 10, 13 and 40 – 42 are rejected under 35 U.S.C. 102(a) as being anticipated by McClain, Timothy J. ("Entrepreneur builds a leading-edge company and Web payment system around his vision of the right way to do Internet marketing"; San Diego Metropolitan Magazine, Cover Story, July 1997, pgs 1-8).

Claims 1: McClain discloses a billing statement comprising:

- a. viewable electronic data, viewable electronic data comprising (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
 - 1. a description of a transaction (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
 - 2. An offer pointer associated with the transaction, wherein the offer pointer was selected by a controller in communication with at least one issuing bank device, wherein the offer pointer comprises information for use to review an offer via a consumer device. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
 - 3. Wherein the transaction is one of a plurality of transactions described in the billing statement and the offer pointer is not associated with any other transactions describe in the billing statement. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
 - 4. Wherein the information comprises a uniform resource locator. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 5: McClain discloses a billing statement according to claim 1, wherein the offer pointer further comprises a code for submission to a website referenced by the uniform resource locator. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 6: McClain discloses a billing statement according to claim 5, wherein the code is associated with the offer. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 10: McClain discloses a billing statement as in Claim 1 above, and further discloses that the offer pointer is not an offer (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 13: McClain discloses a billing statement as in Claim 1 above, and further discloses that the offer is an offer to reduce the amount owed with the associated transaction (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 40: McClain discloses a method comprising

- a. Receiving transaction information associated with a plurality of transactions.
(Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
- b. Determining an offer pointer based on the transaction information, the offer pointer including information for use to review an offer associated with only one

of the plurality of transactions. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

- c. Transmitting, by a controller in communication with at least one issuing bank device, the offer pointer to a consumer device of a customer via a billing statement comprising viewable electronic data for the plurality of transactions. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 41: McClain discloses a method comprising:

- a. Receiving transaction information associated with a plurality of transactions. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
- b. Determining an offer based on the transaction information, wherein the offer is associated with only one of the plurality of transactions. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
- c. Determining, by a controller in communication with at least one issuing bank device, an offer pointer including information for use to review the offer. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
- d. Transmitting the offer pointer to a consumer device of a customer via a billing statement comprising viewable electronic data for the plurality of transactions.

(Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim 42: McClain discloses a method comprising:

- a. Receiving from a consumer device of a customer an offer pointer associated with only one transaction of a plurality of transactions on a billing statement.
(Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)
- b. Transmitting, by a controller in communication with at least one subsidizing merchant device, viewable electronic data including an offer to the consumer device of the customer, the offer being associated with the offer pointer. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 14-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClain, Timothy J. ("Entrepreneur builds a leading-edge

company and Web payment system around his vision of the right way to do Internet marketing"; San Diego Metropolitan Magazine, Cover Story, July 1997, pgs 1-8).

Claim 7: McClain discloses a billing statement as in Claim 1 above (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22) but does not explicitly disclose that the offer pointer is a telephone number.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions for contacting the offeror. The rationale for including a telephone number as the offer pointer is that there are limited number of predictable ways in which the person making the offer can be contacted, and contacting the offeror via telephone is one such predictable contact method.

Claims 14-16: McClain discloses a billing statement as in Claim 1 above, and further discloses the terms of the offer is to reduce the amount owed for the transaction. (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22) While it is not explicitly disclosed that the terms of the offer is to reduce the interest rate, to extend the due date, or to eliminate the minimum amount due, these are all well known types of offer terms used by billers to entice customers to remit payments early, to use a particular form of remittance (electronic vs check), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set the terms of the

offer so as to eliminate the minimum amount due, extend the due date, or change the interest rate. The rationale for setting such terms of the offer is that there are a limited number of predictable types of terms used by billers to entice customers to remit payments early, to use a particular form of remittance (electronic vs check), etc..

Claim 19: McClain discloses a billing statement as in Claims 1 above, (Page 6, line 41 through Page 7, line 24; Page 5, line 31 through Page 6, line 9 and Page 2, lines 16-22) but does not disclose that the offer is located adjacent to the transaction description. However, it is a design choice of the biller on where to place the various information and data on the billing statement page. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the offer adjacent to the transaction information to which the offer pertains. The rationale for placing the offer adjacent to the transaction description is that such a location is one of a limited number of predictable locations that the biller would allow the offer to be placed.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 5-7, 10, 13-16, 19, and 40 – 42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/
John Van Bramer
Primary Examiner, Art Unit 3622